

REMARKS

In an office action mailed October 6, 2004 (Paper No. 20040923), claims 2-15, 17-47, 29-61 and 64-66 were objected to for noted informalities. Claims 1-68 were rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-68 were rejected under 35 U.S.C. 101 as being drawn to non-statutory subject matter. Claims 1-28, 32, and 36-68 were rejected under 35 U.S.C. 102(e) as being anticipated by Bose. Claims 29-31 and 33-35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bose in view of Wang. These rejections are respectfully traversed.

Priority Document

A certified copy of the priority document is being transmitted herewith.

Objections and Rejections under 35 U.S.C. 112 and 101

In response to the objection to the claims and rejection of the claims under 35 U.S.C. 101 and 35 U.S.C. 112, claims 1-15, 17-19, and 27-68 have been cancelled without prejudice or disclaimer, and new claims 69-98 are herewith presented for examination that correct the noted informalities and bases for rejection under 35 U.S.C. 101 and 112. Claim 16 has been amended to include the limitations of dependent claims 17-19, and to correct the objections to those claims and the bases for the rejection of those claims under 35 USC 101 and 112. It is noted that related claims were allowed in Great Britain Patent GB 2,370,450.

Claim 69 is drawn to features related to those of cancelled claims 27, 28, 30 and 31 as filed, plus the feature that the server converts the email messages to an XML format having one or more fields and converts the instant messaging messages to the XML format; and the server transmits the XML format email messages and instant messaging messages to a client, as shown in Figure 3 (see also paragraph [0053]). Consequent amendments have been made to the dependent claims. Claim 85 is an equivalent method claim.

Claim 86 is drawn to features related to those of cancelled claims 48 and 49 plus the feature that the client sends email messages to the server in XML format, as shown in a number

of the exemplary embodiments. Consequent amendments to the dependent claims have also been made. In particular, a system (client and server) has been introduced at claim 94 because cancelled claims 59 to 61 (having elements that are related to those now presented as claims 96 to 98) recited the server but there was no antecedent basis for the server.

Rejections under 35 U.S.C. 102 and 103

Bose fails to provide a basis for the rejection of the claims under 35 U.S.C. 102, because it fails to disclose each element of the claimed invention. Claim 16 includes a "messaging system arranged to transmit messages comprising: a server using an XML message containing an SMTP email message and an instant messaging message, storing the email message, wherein the XML message comprises: a format having delimiters that both mark regions containing values of fields; and identify which fields those are." As discussed below, Bose fails to disclose these elements, and therefore the rejection of claim 16 under 35 U.S.C. 102 must be withdrawn. It should be further noted that the amendments to claims 16 and 21-23 were made solely in response to the objections and rejections under 35 U.S.C. 101 and 112. As such, a subsequent rejection of claim 16 or the claims that depend therefrom on new grounds should not be made final. *See* MPEP 706.07(a) ("A second or any subsequent action on the merits in any application . . . should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. . . . For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.")

Claim 69 includes a "server comprising: a process receiving email messages and instant messaging messages; the server converting the email messages to an XML format and converting the instant messaging messages to the XML format; and the server transmitting the converted email and instant messaging messages to a client." The invention disclosed by Bose modifies hypertext transfer protocol (http) to allow a user behind a firewall to receive server-initiated messages. While firewalls allow a user's browser to make http requests through the firewall to a web server, they do not allow http requests from the web server to the user's computer. Thus, the browser on the user's computer must initiate all activity when standard http protocol is used, which prevents the web server wishes from sending new data to the user, such as an instant message.

Bose discloses that the browser can be modified to make requests to the web server for data that does not yet exist, for example the next instant message from another user. When the web server receives that new data it responds to the outstanding http request by sending that data to the browser as the response to the outstanding http request, which may well have been pending for many minutes. Bose also suggests various uses for this signaling technology, the primary example being an the instant messaging system for use amongst a virtual class of students and a teacher, all who are equipped with a browser to transfer the instant messages between them in an XML format.

One of the uses disclosed by Bose at [0119] is for a "Browser based email systems", i.e. webmail. A problem with webmail is that to see if you have new messages, you must refresh the list of messages in the "Inbox" by requesting the Inbox web page. Bose teaches that if the user's browser sends one of its open http requests the web server can return the message (or a notification of its existence) the moment it arrives. Paragraph [0119] does not disclose, however, that this email notification/delivery can be used in combination with the instant messaging application; paragraph [0119] is simply another use of the http signaling method. Therefore, Bose does not disclose a server having a process "receiving email messages and instant messaging messages; the server converting the email messages to an XML format and converting the instant messaging messages to the XML format; and the server transmitting the converted email and instant messaging messages to a client." Nor does paragraph [0119] disclose that the email, which is in the standard SMTP email format, is converted to XML. Bose fails to disclose both of these points, and therefore fails to provide a basis for the rejection of claim 68 under 35 U.S.C. 102 or 103.

Nor does Bose suggest the integration of instant messaging and email in the manner of claim 68. The motivation of Bose at paragraph [0119] is merely to solve the problem of notifying the user of a webmail system of the arrival of email in a timely fashion. Paragraph [0119] fails to disclose anything about the sending of SMTP format email, and thus fails to disclose converting SMTP format email from a client to a server in an XML format. Indeed in a webmail system there would be no need for the invention of claim 18. To send an email a user would simply use the conventional web page form of the webmail system provided for composing messages.

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All claims not specifically addressed are allowable at least for the reasons that they depend from an allowable base claim and add limitations not present in the prior art. Withdrawal of all rejections and allowance of all claims is respectfully requested.

CONCLUSION

In view of the foregoing remarks and for various other reasons readily apparent, Applicants submit that all of the claims now present are allowable, and withdrawal of the rejections and a Notice of Allowability are courteously solicited.

If any impediment to the allowance of the claims remains after consideration of this amendment, a telephone interview with the undersigned at (214) 939-8678 is hereby requested so that such impediments may be resolved as expeditiously as possible.

A fee of \$510.00 for a three-month extension of time is believed to be required with this response, and a petition therefore is hereby presented. Also enclosed is check number 52443 in the amount of \$690.00 to the U.S. Patent and Trademark Office; \$510.00 of which is allocated as the fee for the three-month extension of time, and \$180.00 of which is for an Information Disclosure Statement, filed herewith. If any applicable fee or refund has been overlooked, the Commissioner is hereby authorized to charge any fee or credit any refund to the deposit account of Godwin Gruber, LLP, No. 50-0530.

Respectfully submitted,

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